

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: S. Edward Mann, II

Serial No.: 09/308,300

Filed: July 14, 1999

For: **COMPUTER TUTORIAL AND EXECUTION INTERFACE
OPERABLE OVER NETWORK CONNECTION**



Attorney Docket: 17322PCTUS

Group Art Unit: 3713

Examiner: Harris, C. L.

#14
12/21/01
R119d

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RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 2327
Arlington, VA 22202
ATTN: Box Non-Fee Amendment

Sir:

In response to the non-final Office Action mailed June 7, 2001, a petition for an extension of time being filed herewith, the Applicant makes the following remarks.

By way of background, this application was originally filed as PCT application No. PCT/US96/18477 filed on November 18, 1996.

For the purposes of the designation of the United States in the PCT application, this application claimed to be a continuation-in-part of U.S. application Serial No. 08/541,221 filed October 12, 1995, which is a continuation of U.S. application Serial No. 08/283,618 filed August 1, 1994, now abandoned.

A continuation of the first U.S. application Serial No. 08/283,618 was filed as Serial No. 541,221 on October 12, 1995, which ultimately issued as U.S. Patent No. 5,577,186.

On March 18, 1998, the claims in the International PCT application were amended under Article 19 of the PCT. The United States Patent and Trademark Office ("USPTO"), acting in its capacity as an International Preliminary Examination Authority, issued an International Preliminary Examination Report transmitted on October 19, 1998, stating that all the 37 claims of the Article 19 Amendment that were then pending in the application meet the criteria for patentability set out in PCT Article 33(1)-(4) over all the patents cited in the International Search Report.

At least partially on the basis of the favorable International Preliminary Examination Report, Applicant entered this PCT application into the national stage in the United States under 35 U.S.C. 371. Because the International preliminary examination fee is paid to the USPTO and all claims satisfied the provisions of PCT Article 33(1)-(4), the basic fee to the USPTO was only \$96. This reduced filing fee is believed to reflect the general understanding that in such cases the national stage prosecution should proceed smoothly, as the USPTO was the International Preliminary Examination Authority.

On July 26, 1999, the USPTO sent Applicant a "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495," which assigned U.S. Serial No. 09/308,300 to the national stage of this application and accorded the date of receipt of 35 U.S.C. 371 requirements in the USPTO as of July 14, 1999.

On November 9, 2001, the Examiner, who is different from the officer acting during the International stage of this application, called the undersigned's office to request that Applicant provide another copy of Form PCT/DO/EO/903 dated July 26, 1999 indicating that the International Preliminary Examination Report had been received by the USPTO at that time and to provide a complete copy of the International Preliminary Examination Report dated October 19, 1998. The undersigned did so that same day via facsimile transmission.

On November 27, 2000, the USPTO mailed a first Office Action in the application, which made only two rejections of the claims:

1. Claims 26-37 were rejected for statutory type double patenting as claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 5,577,186 (a continuation of the first U.S. application Serial No. 08/283,618), which rejection cannot be overcome by a terminal disclaimer; and
2. Claims 1-25 were rejected under the judicially-created doctrine of obviousness type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,577,186, which rejection can be overcome by a terminal disclaimer.

Although the first Office Action mailed November 27, 2000 in the national stage included a citation of pertinent references, the cited references therein were merely "made of record and not relied upon" in making any rejection of the claims. In this regard, the Manual of Patent Examining Procedure ("MPEP"), § 707.07(g) provides that: "Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references."

Based on the first Office Action and the USPTO procedures set forth in the MPEP, Applicant understood that this application could be placed in condition for allowance by amending to cancel claims 26-37 and by submitting a terminal disclaimer as to the remaining Claims 1-25. Applicant did so on April 27, 2001.

But instead of a Notice of Allowance, a second non-final Office Action was then mailed on June 7, 2001. The second Office Action accepted the amendment and terminal disclaimer, but rejected the remaining claims 1-25 based on Chiang et al., U.S. Patent No. 5,442,759, one of the references that had been previously cited as being merely "made of record and not relied upon" in the first Office Action. Furthermore, this time the Office Action cited a completely different list of references as being merely "made of record and not

relied upon” in making any rejection of the claims. It is unclear whether or not the list of such references in the first Office Action that were “made of record and not relied upon” are still considered to be pertinent to Applicant’s disclosure or not. Clarification is respectfully requested.

Furthermore, neither the first Office Action nor the second Office Action made any reference to the prior International Preliminary Examination Report or the references cited therein. According to the MPEP in effect at the time, that is, either the Seventh Edition (E7) 07/1998 or the Seventh Edition First Revision (E7R1) 02/2000, § 1893.03(e):

If the international application underwent preliminary examination, the International Preliminary Examination Report (Form PCT/IPEA/409) reflects the International Preliminary Authority’s non-binding opinion regarding novelty, inventive step and industrial applicability. The examiner may adopt any portion or all of this opinion upon consideration in the national stage so long as it is consistent with U.S. practice. The examiner should comment upon the Report in the first Office action on the merits to reflect that the Report has been considered. The comment may be a mere acknowledgment.

Although an International Preliminary Examination Report is not necessarily binding during subsequent national stage prosecution, MPEP § 704 appears at least pertinent:

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the case or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something.

A national stage application is the same application as the PCT application, including, for example, by having the same filing date. Therefore, at this point, the Applicant does not know which of the three different sets of cited references that have been cited in the previous lengthy prosecution of this application that the USPTO intends to rely on in this application. Clarification is respectfully requested.

Finally, the pending rejections of Claims 1-25 based on Chiang et al. (U.S. Patent No. 5,442,759) and the comments in the Office Action mailed June 7, 2001 are not understood. Regarding the rejection of claims 1-11, 13-20, 22-25 under 35 U.S.C. 102(b) as being clearly anticipated by Chiang et al., the Office Action does not provide any explanation whatsoever as to how the claims are being interpreted and applied to this cited reference. The brief comments in the Office Action regarding the rejection of dependent claims 12 and 21 under 35 U.S.C. 103(a) as being unpatentable over Chiang et al. shed no light on how the reference is being applied to the independent claims under 35 U.S.C. 102(b). Applicant respectfully traverses these rejections of the pending claims 1-25 in the application and respectfully requests that these rejections be withdrawn or explained.

And the Applicant is concerned that the prosecution of this application is not proceeding smoothly, which is time-consuming, confusing, and much more costly than expected. This application is now up for a third action on the same claims, not even counting the International Preliminary Examination Report. See MPEP § 707.02(a). Pending claims 1-25 in this application are literally the same and have not been amended since they were considered in the International Preliminary Examination Report in 1998.

If another substantive Office Action is required to define the issue between the Examiner and the Applicant, then the Applicant respectfully requests that it be made non-final.

As stated in the MPEP, (the current) Eighth Edition (E8) 08/2001, § 706.07:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the case or a final rejection.

If a telephone interview would expedite the prosecution of this application or help clarify any misunderstandings, the undersigned would appreciate a call and can normally be reached at the number below.

Dated: December 7, 2001

CERTIFICATE OF MAILING BY "EXPRESS MAIL"
"EXPRESS MAIL" MAILING LABEL NO. EF060645635US
DATE OF DEPOSIT: December 7, 2001

I HEREBY CERTIFY THAT THE ENCLOSED PAPER OR FEE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE "EXPRESS MAIL POST OFFICE TO ADDRESSEE" SERVICE UNDER 37 CFR 1.10 ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE ASSISTANT COMMISSIONER OF PATENTS, UNITED STATES PATENT AND TRADEMARK OFFICE, BOX 2327, ARLINGTON, VA 22202, ATTN: BOX NON-FEE ASSIGNMENT

Todd E. Albanesi
Printed Name of Person Mailing Paper or Fee
Todd E. Albanesi
Signature of Person Mailing Paper or Fee

Respectfully submitted,

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